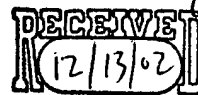


Official



Practitioner's Docket No. UK9-99-029

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Renshaw, D.
Application No.: 09/452,927
For: Form Data File Generator

Examiner: Chuck O. Kendall

Commissioner for Patents
Washington, D.C. 20231

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION
— FINAL REJECTION PREMATURE

1. I hereby petition to withdraw the finality of the Office Action mailed on October 24, 2002, on the basis that the Final Rejection was premature.
2. Facts:
 - (A) Applicant filed a response to the first Office Action on August 13, 2002.
 - (B) The Response included a Declaration under 37 CFR 1.131 which indicated that the subject invention was invented prior to the effective date of the Alcorn reference, which was the primary reference used to reject the claims of the subject Application in the first Office Action.
 - (C) The Response included arguments as to why the claims were not obvious in view of the cited art, including Alcorn.
 - (D) Applicant did not amend the claims.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*
(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- ☐ deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, Washington D.C. 20231
37 C.F.R. § 1.8(a)

☐ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"
Mailing Label No. _____ (mandatory)

TRANSMISSION

X facsimile transmitted to the Patent and Trademark Office. (703) 746 - 7238.

Date:
Dec. 13, 2002

Signature

Linda Dupont

(Type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

- (E) A Final Rejection was mailed on October 24, 2002.
- (F) A new grounds of rejection was included for the independent claims which did not include the Alcorn reference.
- (G) Some of the dependent claims were rejected with reference to a rejection of Claim 1 which included Alcorn, which was not included in the Final Rejection.
- (H) No discussion of the Declaration under 37 CFR 1.131 was included in the Final Rejection, and none of the form paragraphs identified in MPEP Section 715 with respect to such a declaration was included in the Final Rejection.
- (I) The Office Action was made final because "Applicant's amendment necessitate the new ground(s) of rejection presented in this Office action" despite there being no amendments made to the Application.

3. Discussion

MPEP Section 706.07(a) states that "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

As noted above, Applicant did not amend the claims in the subject Application. Further, Applicant did not submit an information disclosure statement filed during the prescribed period. Also as noted above, the Office Action was made final because of "Applicant's amendment", which has been demonstrated to be non-existent.

In a telephone interview with the Examiner, the Examiner seemed to indicate that the Declaration under 1.131 was being considered an amendment to the claims for purposes of Section 706.07(a). This interpretation is unsupported by the MPEP, contrary to any accepted understanding of the meaning of the phrase "amendment of the claims," and therefor an arbitrary and capricious application of the controlling regulations for the United States Patent & Trademark Office.

Further, there was no indication in the Final Rejection that the Declaration had overcome the Alcorn reference. As noted above, Alcorn was still utilized in the Final Rejection. Applicant presented an argument in his response which showed how the claims distinguished over Alcorn. Accordingly, as a new ground of rejection was presented in the Final Rejection without amendment to the claim, the finality of the Office Action is premature, as there is no evidence that the Declaration was considered by the USPTO.

- 4. In consideration of these arguments, it is respectfully requested that the holding of finality of the Office Action be withdrawn.

6. The petition fee (37 C.F.R. § 1.17(h)–\$130.00) is paid as follows:

Authorization is hereby made to charge the amount of \$130.00 to Deposit Account No. 09/0461.

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.



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